

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No.: 10/811,387

Attorney Docket No.: Q80738

AMENDMENTS TO THE DRAWINGS

Attachment: 1 Replacement Sheet(s)

REMARKS

I. Preliminary Matters

Claims 1-8 are pending in the application, and all claims are rejected.

II. Examiner's Note

The Examiner rejects claims 1 and 4-8 for not complying with the requirements of 35 U.S.C. § 112, sixth paragraph. The Applicant respectfully traverses the rejection. M.P.E.P. section 2181 recites:

“A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase ‘means for’ or ‘step for;’

(B) the ‘means for’ or ‘step for’ must be modified by functional language; and

(C) the phrase ‘means for’ or ‘step for’ must not be modified by sufficient structure, material, or acts for achieving the specified function.”

The Examiner concedes the requirements of the first prong of the 35 U.S.C. § 112, sixth paragraph requirements are met, but alleges the other prongs are not (Office Action, page 2).

The Applicant respectfully disagrees with the Examiner. Claim 1 recites three different means limitations: a sending means, a separating means, and a transmission control means. As required by the last two prongs of the 35 U.S.C. § 112, sixth paragraph test, each of these means limitations are modified by functional, not structural language. The sending means performs the function of sending a medical image, just as the separating means separates the medical image into supplementary information and an image body. The transmission control means controls the sending means in a certain manner. In these ways, the “means” language is modified by functional language. Additionally, none of these recited functions modify the “means” limitations with sufficient structure as prohibited by the third prong of the means-plus-function test. Therefore, claim 1 should overcome the 35 U.S.C. § 112, sixth paragraph rejection.

While the Examiner rejects claims 1, and 4-8 for the lack of specific structural limitations in the specification under 35 U.S.C. § 112, sixth paragraph (Office Action, page 2), the Applicant respectfully submits the alleged lack of specific structural limitations are not relevant to a 35 U.S.C. § 112, sixth paragraph rejection. However, the Examiners own rejection supports the view that at least a computer-based implementation is decided by the current application. Therefore, the claims meet all requirements of 35 U.S.C. § 112.

Claims 4 and 5 depend from claim 1 and should be patentable for at least the same reasons as claim 1. Claim 6 recites analogous limitations as claim 1 and should be patentable at least for analogous reasons. Claims 7 and 8 depend from claim 6 and should be patentable for at least the same reasons as claim 6.

III. Drawings

The Examiner objects to Fig. 2 because “Minitor,” object 17, should be “Monitor.” A replacement sheet for Fig. 2 is attached.

IV. Specification

The Examiner objects to page 6, line 2 of the Specification as not including acronyms for “FD, CD-R, and MO” (Office Action, page 3).

The paragraph has been amended and as such the Applicant respectfully requests the objection to be removed.

V. Claim Rejections Under 35 U.S.C. § 102

Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jain (U.S. Patent No. 5,559,888). The Applicant respectfully traverses the rejection.

Claim 1 recites, *inter alia*, an image sending device comprising:

“a separating means for separating the medical image into
the supplementary information and an image body.”

Jain recites a secure information retrieval service that comprises three levels of confidential access to a database. Nowhere throughout the specification of Jain is a “medical image,” “supplementary information,” or “an image body” disclosed as recited in independent

claims 1 or 6. the Examiner attempts to equate “information” to a medical image and “selective access” to a separating means (Office Action, page 4). However, a “medical image” and a “separation means” are far more specific than these characterizations and the Specification of Jain would not disclose these features to one of ordinary skill in the art. The selective access disclosed in Jain does not refer to the data separation of the present invention, but rather to data retrieval from databases. Even if Jain is alleged to disclose the three databases, 20, 22, and 24, at different security levels implying the separation of the data set into three security levels, Jain still does not disclose the separation of the medical image into the supplementary information and the image body. Therefore, claims 1 and 6, and all claims which depend from them are patentable.

To the extent Jain treats data with different security levels, none of the transmission relates to an image body. Rather, it appears only textual matter is described by Jain. Moreover, Jain treats patent privacy information at a less secure level than any associated medical prognosis. By contrast, claim 1 describes privacy data being treated at a high level of security.

Additionally, Jain does not disclose the “associating means” of claim 5. The “associating the supplementary information with the image body” as recited in claim 5 is different than the selection of which level of security the particular information is stored in the teachings of Jain. Therefore, claim 5 should be patentable.

Claims 9 and 10 have been added to describe the invention with more particularity.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

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